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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/835,261	04/12/2001	Hans-Michael Kuhl	22750/405A	5004
26646	7590	02/27/2006	EXAMINER	
KENYON & KENYON LLP ONE BROADWAY NEW YORK, NY 10004			DICUS, TAMRA	
			ART UNIT	PAPER NUMBER
			1774	

DATE MAILED: 02/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/835,261	KUHL ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Tamra L. Dicus	1774	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-3,5 and 6 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,5 and 6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### DETAILED ACTION

The rejection over US Kjellqvist in view of Lussi is withdrawn due to Applicant's submission of the English translation of the foreign application.

#### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-3, and 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 98/10160 to Kjellqvist et al. in view of USPN 5,571,588 to Lussi et al.

Kjellqvist provides for floor coverings using copolymers containing  $\alpha$ -olefins having 2-20 carbons at page 5, lines 5-14 containing monomer ethylene or a combination of ethylene with  $\alpha$ -olefins. Testing properties such as ultimate tensile strength and elongation are measured according to DIN 53504, specimen S2, 50 mm/min. cross head speed (see page 32-33). The elongation percentages are taught in Tables 3 and 4 ranging from 31.9 to 776 % (meeting applicant's range of a minimum elongation of 60%). The weight percent and melt flow index of ethylene/styrene copolymer ranges from 1-30 g/10 min in Table 1C (col. 19, lines 40-55) (meeting applicant's range of 0.1 to 50). The floor covering of Kjellqvist generally has a thickness of from about 0.025 mm to about 25 mm (see page 25, lines 34-page 26, line 15), meeting Applicant's claimed range of 1.5 – 3.5 mm. Pages 44 and 47 explain floor coverings are useful as homogeneous coverings or as an individual layer in a heterogeneous structure. At

Art Unit: 1774

page 31, line 3, pigments may also be included. At page 28, lines 15-22, Kjellqvist teaches the floor coverings can contain adhesive and decorative layers.

Kjellqvist shows the specific percentages by weight of the copolymer and comonomer, as in instant claims 1 and 2, effect the scratch and abrasion resistance. See page 22, line 23- page 23, line 35 to the amounts of interpolymer, homopolymer, copolymer, and ethylene  $\alpha$ -olefins weight percentages falling within 3 to 20 percent of a copolymer of ethylene. See again Table 1C, pg. 39 teaching the binary interpolymer styrene/ethylene where the styrene wt% ranges from 28.4 to 73.8 wt% and the remainder ethylene equating to  $100 - 28.4\% = 71.6\%$  to  $100 - 73.8\% = 26.2\%$ , falling within Applicant's ethylene content of copolymer being 40-95% and comonomer content 5 to 60%. Applicant also uses styrene (page 7, lines 10-20) and ethylene (page 3, lines 29-34). Because both Applicant and Kjellqvist use styrene as the  $\alpha$ -olefin comonomer and Kjellqvist teaches a binary, two component, interpolymer including both styrene and ethylene as explained above, the weight percentages are covered.

Kjellqvist does not teach a multicolored pattern provided by granular particles as instant claims 1, 3, and 5-6 require.

Lussi teaches floor coverings with unpatterned decorative appearances. Lussi teaches at col. 5, line 65-col. 6, line 2 multicolored spheroidal resinous particles (granular particles) are used to give a uniform, unpatterned, textured inlaid appearance to the floor coverings. The particles comprise PVC (see col. 5, line 63). The floor covering includes crosslinkable copolymers in the latex layer, which include crosslinkable ethylene vinyl acetate latexes, crosslinkable acrylic latexes, ethylene vinyl chloride emulsions, PVC and polyvinyl acetate latexes, PVC and polyvinyl acetate copolymer latexes, and butadiene-acrylonitrile latexes. The

Art Unit: 1774

latex layer includes color, providing for a multicolored or single color (instant claims 1, 3, and 5-6). See col. 4, lines 20-30.

It would have been obvious to one of ordinary skill in the art to modify the floor covering of Kjellqvist to include granular colored (multi-and single colored) particles in a pattern because Lussi teaches doing so with similar materials to create a textured colored floor covering as cited above.

To the limitation “wherein the floor covering having widths of 1 m to 2 m and has no change in thickness exceeding +5% over the width,” neither prior art reference teaches, however this limitation is an optimizable feature. The experimental modification of this prior art in order to ascertain optimum operating conditions fails to render Applicant’s claims patentable in the absence of unexpected results. *In re Aller*, 105 USPQ 233. It would have been obvious to one of ordinary skill in the art to produce a width as recited, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272. The combination teaches the same article, thus patentable weight is not given to width requirements, absent any evidence to the contrary. Such ranges width and thicknesses are properties which can be easily determined by one of ordinary skill in the art. With regard to the limitation of the ranges of width and thicknesses, absent a showing of unexpected results, it is obvious to modify the conditions of a covering because they are merely the result of routine experimentation. The experimental modification of prior art in order to optimize operation conditions (e.g. ranges of width and thickness) fails to render claims patentable in the absence of unexpected results.

*Response to Arguments*

Applicant's arguments filed 11-21-05 have been fully considered but they are not persuasive. Applicant's argue that the WO reference on page 23, lines 21-32 teach a blend of different interpolymers and not the specific weight percentages (ethylene copolymer from 40-95% wt, the comonomer content from 50-60%wt) as per instant claim 1. Applicant's contends that because these weight percentages are not explicitly taught, that they are not result effective further alleging that there is no evidence to support an obviousness rejection over claim 1.

The WO reference teaches all the elements except for the colored pattern on top and the thickness. Applicant argues the WO reference to Kjellqvist teaches a blend and not a single copolymer. Applicant may not have considered the explicit teaching on page 22, lines 23+ and Table 1C of the WO reference that state the interpolymers or homopolymers include homopolymers and copolymers of ethylene including alpha-olefins and any combination thereof. Such teaching indeed includes the copolymers and comonomers of ethylene as instant claim 1 recites. Interpolymers and blends of them are generic to the comonomers and copolymers of the claim. Kjellqvist shows the specific percentages by weight of the copolymer and comonomer, as in instant claims 1 and 2, effect the scratch and abrasion resistance. See page 22, line 23- page 23, line 35 to the amounts of interpolymer, homopolymer, copolymer, and ethylene  $\alpha$ -olefins weight percentages falling within 3 to 20 percent of a copolymer of ethylene. See again Table 1C, pg. 39 teaching the binary interpolymer styrene/ethylene where the styrene wt% ranges from 28.4 to 73.8 wt% and the remainder ethylene equating to  $100-28.4\% = 71.6\%$  to  $100-73.8\% = 26.2\%$ , falling within Applicant's ethylene content of copolymer being 40-95% and comonomer content 5 to 60%. Applicant also uses styrene (page 7, lines 10-20) and ethylene (page 3, lines

Art Unit: 1774

29-34). Because both Applicant and Kjellqvist use styrene as the  $\alpha$ -olefin comonomer and Kjellqvist teaches a binary, two component, interpolymer including both styrene and ethylene as explained above, the weight percentages are covered. The ranges of the WO reference teaches said polymers (from one monomer unit to more than one forming polymers) effects abrasion resistance (page 23, line 20). Thus, sufficient evidence has been presented and hindsight was not employed as alleged by Applicant.

The thickness is optimizable because width effects how thin the covering is. Size of an article does not render the article patentable just because it is a different size.

Further, Applicant has not presented evidence to dispute the prior art teachings to show unexpected results. A *prima facie* case has been established, and therefore the burden shifts to the Applicant to submit additional objective evidence of nonobviousness, such as comparative test data showing that the claimed invention possesses improved properties not expected by the prior art. Arguments of counsel cannot take the place of factually supported objective evidence. See, e.g., *In re Huang*, 100 F.3d 135,139-40, 40 USPQ2d 1685, 1689 (Fed. Cir. 1996); *In re De Blauwe*, 736 F.2d 699,705, 222 USPQ 191, 196 (Fed. Cir. 1984). Until the Applicant has convincingly argued or has provided evidence to the contrary, the rejections are maintained.

Lussi is still used to show that it was obvious to add colored granules in a pattern to show a textured colored effect as Applicant desires.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 1774

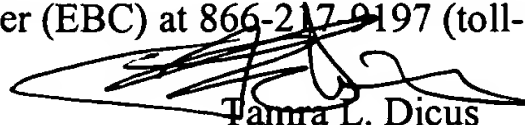

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is 571-272-1519. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

February 21, 2006

  
Tamra L. DicusExaminer  
Art Unit 1774  
RENA DYE  
SUPERVISORY PATENT EXAMINER  
A.U. 1774 2/21/06